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By: _____

Nancy Foster

PATENT

Customer Number: 22,852
Attorney Docket No. 04121.0003-02000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Joseph A. SORGE et al.) Group Art Unit: 1637
Application No.: 08/529,767)
Filed: September 18, 1995)
For: NOVEL POLYMERASE) Examiner: J. FREDMAN
COMPOSITIONS AND USES)
THEREOF) Confirmation No. 4454
)
)

MAIL STOP RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97(b)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), applicants bring to the attention of the Examiner the documents listed on the enclosed IDS Form PTO/SB/08. This Information Disclosure Statement is being filed with a Request for Continued Examination.

Copies of the listed foreign patent documents, non-patent literature documents, and other documents are enclosed. Copies of the U.S. patents and patent publications are not enclosed.

Certain listed documents are copies of documents filed in Interference No. 105,320. Interference No. 105,320 is an interference between U.S. Patent No.

6,410,277 ("the '277 Barnes patent") and the present application, U.S. Patent Application No. 08/529,767 ("the '767 Sorge application"). The '277 Barnes patent is a continuation-in-part of U.S. Patent Application No. 08/483,535, which is a continuation-in-part of U.S. Patent Application No. 08/021,623, which issued as U.S. Patent No. 5,436,149 ("the '149 Barnes patent"). The '767 Sorge application is a divisional of U.S. Patent Application No. 08/197,791, which issued as U.S. Patent No. 5,556,772 ("the '772 Barnes patent").

Certain listed documents are copies of documents filed in Reexamination Nos. 90/006,571 and 90/007,004 ("the Reexaminations"). The Reexaminations are merged reexaminations of the '772 Barnes patent. Because the Reexaminations are merged, applicants have only filed a single copy of documents that were filed in duplicate in the merged reexaminations.

Also, among the documents filed in the Reexaminations are the Declaration of Joseph A. Sorge Under 37 C.F.R. § 41.202(d), the Declaration of Rebecca Mullinax, the Declaration of Ronni L. Sherman, and the Declaration of Denise Wyborski. Exhibits 1 to 69 of the Declaration of Joseph A. Sorge Under 37 C.F.R. § 41.202(d) are the same as Exhibits 1 to 69 of the Declaration of Rebecca Mullinax and Exhibits 1 to 69 of the Declaration of Ronni L. Sherman. Also, Exhibits 1 to 9 of the Declaration of Joseph A. Sorge Under 37 C.F.R. § 41.202(d) are the same as Exhibits 1 to 9 of the Declaration of Denise Wyborski. Because those exhibits are the same, applicants have submitted the Declaration of Joseph A. Sorge Under 37 C.F.R. § 41.202(d) with Exhibits 1 to 69 in this IDS, but have submitted the Declaration of Rebecca Mullinax, the Declaration of Ronni L. Sherman, and the Declaration of Denise Wyborski without exhibits.

Applicants respectfully request that the Examiner consider the listed documents and evidence that consideration by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and applicants determine that the cited documents do not constitute "prior art" under United States law, applicants reserve the right to present to the Office the relevant facts and law regarding the appropriate status of such documents.

Applicants further reserve the right to take appropriate action to establish the patentability of the claimed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

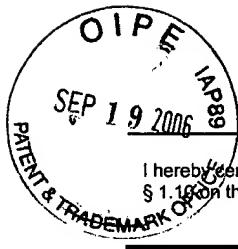
If there is any fee due in connection with the filing of this Statement, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 19, 2006

By: 
Michael R. Albrecht
Reg. No. 54,956
Customer No. 22,852



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By: *Nancy Foster*

IDS Form PTO/SB/08: Substitute for form 1449A/PTO				Complete if Known	
				<i>Application Number</i>	08/529,767
				<i>Filing Date</i>	September 18, 1995
				<i>First Named Inventor</i>	Joseph A. SORGE et al.
				<i>Art Unit</i>	1637
				<i>Examiner Name</i>	J. FREDMAN
Sheet	1	of	4	<i>Attorney Docket Number</i>	04121.0003-02000

U.S. PATENTS AND PUBLISHED U.S. PATENT APPLICATIONS					
Examiner Initials	Cite No. ¹	Document Number	Issue or Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
		4,376,110	03-08-1983	David et al.	
		4,683,202	07-28-1987	Mullis	
		4,795,699	01-03-1989	Tabor et al.	
		4,800,159	01-24-1989	Mullis et al.	
		4,921,794	05-01-1990	Tabor et al.	
		4,946,786	08-07-1990	Tabor et al.	
		5,001,050	03-19-1991	Blanco et al.	
		5,075,216	12-24-1991	Innis et al.	
		5,079,352	01-07-1992	Gelfand et al.	
		5,210,036	05-11-1993	Comb et al.	
		5,310,652	05-10-1994	Gelfand et al.	
		5,322,785	06-21-1994	Comb et al.	
		5,352,785	10-04-1994	Herzberg et al.	
		5,352,778	10-04-1994	Comb et al.	
		5,374,553	12-20-1994	Gelfand et al.	
		5,422,239	06-06-1995	Wands et al.	
		5,466,591	11-14-1995	Abramson et al.	
		5,489,523	02-06-1996	Mathur	
		5,500,363	03-19-1996	Comb et al.	
		5,545,552	08-13-1996	Mathur	
		5,618,702	04-08-1997	Scanlon	
		6,410,277	06-25-2002	Barnes	

Note: Submission of copies of U.S. Patents and published U.S. Patent Applications is not required.

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	Translation ⁶
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)				
		EP 0 265 293 A2	04/27/1988	The President and Fellows of Harvard College		
		EP 0 386 857 A2	09/12/1990	The President and Fellows of Harvard College		

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

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of

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Complete if Known

<i>Application Number</i>	08/529,767
<i>Filing Date</i>	September 18, 1995
<i>First Named Inventor</i>	Joseph A. SORGE et al.
<i>Art Unit</i>	1637
<i>Examiner Name</i>	J. FREDMAN
<i>Attorney Docket Number</i>	04121.0003-02000

FOREIGN PATENT DOCUMENTS

	EP 0 416 755 A1	03/13/1991	Life Technologies Inc.	
	WO 89/06691 A2	07/27/1989	Cetus Corporation	
	WO 91/02090 A1	02/21/1991	Promega Corporation	
	WO 92/06188 A2	04/16/1992	Barnes	
	WO 92/06200 A1	04/16/1992	Cetus Corporation	

NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	Translation ⁶
		Anonymous, "Recombinant Vent _R ™ DNA Polymerase," <i>The NEB Transcript</i> , 3(1):4 (1991).	
		Barnes, "PCR amplification of up to 35-kb DNA with high fidelity and high yield from λ bacteriophage templates," <i>Proc. Natl. Acad. Sci. USA</i> , 91:2216-2220 (1994).	
		Cheng et al., "Effective amplification of long targets from cloned inserts and human genomic DNA," <i>Proc. Natl. Acad. Sci. USA</i> , 91:5695-5699 (1994).	
		Lawyer et al., "High-level expression, purification, and enzymatic characterization of full-length <i>Thermus aquaticus</i> DNA polymerase and a truncated form deficient in 5' to 3' exonuclease activity," <i>PCR Methods and Applications</i> , 2:275-287 (1993).	
		Lehninger et al., <i>Principles of Biochemistry</i> , 2 nd Edition, Worth Publishers, New York, NY, pp. 822-824 (1993).	
		Livingston et al., "Affinity chromatography of avian type C viral reverse transcriptase: Studies with Rous Sarcoma Virus transformed rat cells," <i>Virology</i> , 50:388-395 (1972).	
		Mattila et al., "Fidelity of DNA synthesis by the <i>Thermococcus litoralis</i> DNA polymerase - an extremely heat stable enzyme with proofreading activity," <i>Nucleic Acids Research</i> , 19(18):4967-4973 (1991).	
		Morrison et al., "Eukaryotic DNA polymerase amino acid sequence required for 3' → 5' exonuclease activity," <i>Proc. Natl. Acad. Sci. USA</i> , 88:9473-9477 (1991).	
		Perrino et al., "Differential extension of 3' mispairs is a major contribution to the high fidelity of calf thymus DNA polymerase-α," <i>J. Biol. Chem.</i> , 264: 2898-2905 (1989).	
		Sears et al., "CircumVent™ thermal cycle sequencing and alternative manual and automated DNA sequencing protocols using the highly thermostable Vent _R ™ (exo-) DNA polymerase," <i>BioTechniques</i> , 13(4):626-633 (1992).	
		Uemori et al., "Organization and nucleotide sequence of the DNA polymerase gene from the archaeon <i>Pyrococcus furiosus</i> ," <i>Nucleic Acids Research</i> , 21(2):259-265 (1993).	
		The Stratagene Catalog, Gene Characterization Kits, p. 39 (1988).	

OTHER DOCUMENTS (from U.S. Patent Application No. 10/319,778, filed on December 13, 2002)

	Supplementary Preliminary Amendment filed July 18, 2003.	
	Office Action mailed February 14, 2006.	
	Response including Declaration of Joseph A. Sorge and Rebecca L. Mullinax Under 37 C.F.R. § 1.131, filed July 14, 2006.	
	Office Action mailed August 16, 2006.	

OTHER DOCUMENTS (from U.S. Patent Application No. 11/230,945, filed on September 19, 2005)

	Preliminary Amendment filed September 19, 2005, in U.S. Patent Application No. 11/230,945.	
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Complete if Known

<i>Application Number</i>	08/529,767
<i>Filing Date</i>	September 18, 1995
<i>First Named Inventor</i>	Joseph A. SORGE et al.
<i>Art Unit</i>	1637
<i>Examiner Name</i>	J. FREDMAN
<i>Attorney Docket Number</i>	04121.0003-02000

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet

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of

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Sheet	3	of	4	Attorney Docket Number	04121.0003-02000
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OTHER DOCUMENTS (from Reexamination Control No. 90/006,571, reexamination request filed March 20, 2003)

	Request for Additional Decision , filed by Morrison and Foerster on June 10, 2003.	
	Letter Submitting Copy of Request by Takara Bio Inc. for Leave to Participate in this Reexamination as a Partial Assignee (Co-owner) and other Takara Bio Inc. Submissions filed August 18, 2003.	
	Information Disclosure Statement by Takara Bio Inc. as a Partial Assignee (Co-Owner) and Form PTO 1449, filed by Fish and Richardson P.C. on January 22, 2004.	
	Decision Returning Petition mailed January 30, 2004.	
	Decision Returning Petition received February 5, 2004.	
	Decision Returning Improper Paper mailed February 6, 2004.	
	Office Action in Ex Parte Reexamination mailed March 10, 2004.	
	Amendment filed May 10, 2004.	
	Decision Merging Reexamination Proceedings mailed August 19, 2004.	
	Office Action in Ex Parte Reexamination mailed December 20, 2004.	
	Response, including copy of Declaration of Joseph A.. Sorge and Rebecca L. Mullinax Under 37 C.F.R. § 1.131 with Exhibits A & B; copy of Amendment Under 37 C.F.R. § 1.115, and copy of Eli Lilly v. Board of Regents of the University of Washington, filed February 22, 2005.	
	Office Action in Ex Parte Reexamination mailed March 28, 2005.	
	Response with copy of Louis v. Okada, filed May 31, 2005.	
	Copy of Declaration of Joseph A. Sorge Under 37 C.F.R. § 41.202(d), with Exhibits 1-69, filed May 31, 2005.	
	Copy of Declaration of Rebecca Mullinax, without Exhibits 1-69, filed May 31, 2005.	
	Copy of Declaration of Ronni L. Sherman, without Exhibits 1-69, filed May 31, 2005.	
	Copy of Declaration of Denise Wyborski, without Exhibits 1-9, filed May 31, 2005.	
	Copy of Declaration of Erikka Breedlove filed May 31, 2005.	
	Notice of Intent to Issue Ex Parte Reexamination Certificate mailed September 26, 2005.	
	Petition Under 37 C.F.R. § 1.181(a)(3) to the Director in Person Requesting Withdrawal of Improper Notice of Intent to Issue Reexamination Certificate submitted by Takara Bio, with Exhibits A-H, filed by Morrison and Foerster on October 18, 2005.	
	Decision Dismissing and Returning Petition mailed December 22, 2005.	
	Renewed Petition Under 37 C.F.R. § 1.181 Requesting Withdrawal of Improper Notice of Intent to Issue Reexamination Certificate submitted by Takara Bio, with Exhibits A-H, filed by Morrison and Foerster on January 4, 2006.	
	Decision Dismissing and Returning Petition mailed January 30, 2006.	
	Copy of Letter to John M. Whealan, Esq., Deputy General Counsel for Intellectual Property Law and Solicitor at the U.S. Patent and Trademark Office, dated February 8, 2006, with Exhibits A to D.	
	Office Action in Ex Parte Reexamination mailed March 23, 2006.	
	Response, including copies of Pall Corp. v. Micron Separations, Inc. and Declaration of Wayne M. Barnes dated May 27, 1994, filed May 23, 2006.	
	Notice of Intent to Issue Ex Parte Reexamination Certificate mailed July 20, 2006.	
	Comments on Statement of Reasons for Patentability and/or Confirmation filed August 16, 2006	
	Petition Under 37 CFR. §§ 1.181 and 1.183 Requesting Withdrawal of Improper Notice of Intent to Issue Reexamination Certificate, with Exhibits A to I, filed by Morrison and Foerster on September 8, 2006.	
	Copy of Letter to John M. Whealan, Esq., Deputy General Counsel for Intellectual Property Law and Solicitor at the U.S. Patent and Trademark Office, dated September 14, 2006, with Exhibits A to I.	

Complete if Known

INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		<i>Application Number</i>	08/529,767
		<i>Filing Date</i>	September 18, 1995
		<i>First Named Inventor</i>	Joseph A. SORGE et al.
		<i>Art Unit</i>	1637
		<i>Examiner Name</i>	J. FREDMAN
		<i>Attorney Docket Number</i>	04121.0003-02000
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OTHER DOCUMENTS (from Reexamination Control No. 90/007,004 reexamination request filed April 9, 2004)

		Request for Reexamination Under 37 C.F.R. § 1.510 with Exhibits A-K, filed by Morrison and Foerster on April 9, 2004.	
		Notice of Reexamination Request Filing Date mailed April 28, 2004.	
		Notice of Assignment of Reexamination Request mailed April 28, 2004.	
		Order Granting/Denying Request for Ex Parte Reexamination mailed May 28, 2004.	
		Amendment filed September 2, 2004.	

OTHER DOCUMENTS (Stratagene v. Takara Bio, Inc. (Barnes v. Sorge) Interference No. 105,320)

		Declaration-Bd.R. 203(d) mailed October 12, 2005.	
		Sorge Clean Copy of Claims filed October 26, 2005.	
		Barnes's Clean Copy of Claims filed October 26, 2005.	
		Seventh Stipulated Extension of Time filed May 24, 2006.	
		Barnes's Request for Entry of Adverse Judgment mailed June 12, 2006.	
		Judgment - Request for Adverse - Bd.R. 127(b) filed June 22, 2006.	
		Errata filed June 29, 2006.	

Examiner
SignatureDate
Considered

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.